Rules 75, 94, 96, and 124, Read in the Light of Decisions Explanatory Thereof.

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The purpose of this paper may be thus explained:

A number of the Rules of Practice have been amended, and some new rules have been added in view of, or in consequence of, certain decisions of the Commissioners and the courts. Other rules have had their meaning more fully explained or their scope more clearly indicated in decisions of the Commissioners. What I purpose to do is to consider a few of these rules in connection with the decisions on which they are founded or which interpret and explain their meaning, in the effort to thus render less difficult and more accurate the application of the rules to particular cases.

RULE 75.

A number of important decisions have been rendered by several Commissioners with regard to the nature of the showing that must be made under Rule 75 for the purpose of overcoming references. The first of these in order of date was *Ex parte* Gasser, 17 O. G., 507, in which Commissioner Paine held as follows:

> "The applicant, being rejected on an unexpired patent, shows, by an affidavit filed under Rule 74 (now 75), 'that he made the invention' before the filing of the patented application. This is a mere assertion of invention. 'It may embody a legal opinion as well as facts. To avoid a rejec-

tion on an unexpired patent the applicant is required by Rule 74 to make oath to 'facts showing the completion of the invention before the filing of the application for the domestic patent.' It is not necessary that the earliest actual date of his invention should be shown, but he must show a date prior to the filing of the application on which the unexpired patent was granted.

"The rule is not to be so interpreted as to deny a patent or an interference to an inventor who, being first to conceive a device, was diligent in the prosecution of his invention, but was not the first to reduce it to practice. But it is to be so construed as to require the applicant to make oath to facts showing his right to a date of invention prior to that of the filing of the patented application. The applicant, therefore, must state on oath facts showing either that a reduction to practice had been made before the filing of the application on which the patent was granted, or that the invenhad been conceived before that time, and by due diligence connected with a subsequent reduction to practice."

This decision was followed by *Ex parte* Saunders, 23 O. G., 1224; *Ex parte* Hunter, 49 O. G., 733; and *Ex parte* Donovan, 52 O. G., 309, in which decisions *Ex parte* Gasser was approved and in which the Commissioners at considerable length set forth the nature of the proof required by Rule 75 in order to overcome an anticipating reference. The mere naked statement of an applicant that he completed the invention prior to a specified date was said to be an insufficient compliance with the rule, which requires an oath to facts showing a completion of the invention by him before a certain date. If the applicant rests his claim of invention upon drawings or devices made by him, he should produce such drawings or devices or furnish copies or representations of the same, in order that the office may judge whether he in fact made the invention claimed in his application before the date specified.

In the development of an invention from its first crude conception and embodiment to the perfected form in

which it is disclosed in an application for patent, it might be the belief of the applicant that at a certain date he had made the invention disclosed in a cited reference. This, however, would be a mere matter of opinion. Different minds might reach different conclusions. It was accordingly held in *Ex parte* Saunders, that—

> "no patent will hereafter be granted, therefore, for inventions disclosed in prior patents or publications until the applicant shows by exhibits or descriptions properly verified by oath that the invention was made and completed by him in a patentable sense before the date of the application upon which the patent was granted or before the date at which the printed publication was made."

The purpose of these decisions with reference to the kind of showing required under Rule 75 is to put before the examiner in a tangible way, evidence upon which the applicant relies to overcome a reference, so that the examiner may be in a position to determine whether or not the rejected claim covers the article or machine which applicant avers he made before the date of the anticipating reference. If the rule permitted the mere statement, under oath, of the applicant that he completed the invention before the date of the reference, to be sufficient to overcome such reference as an anticipation of the claim, it would permit the question of anticipation to be decided by the opinion of the applicant. This is the function of the examiner. Drawings or a model are preferable for the reason that they show in a more definite and distinct way than could any verbal description, no matter how complete it might be, just what was the antedating device. Under the well-recognized rules of evidence, it would be best if the device itself and not merely a model or drawing thereof should be filed. Ordinarily, however, at least in the case of machines, this would be impracticable, and accordingly, the ordinary practice is to file models or drawings. Models or drawings are also generally preferable, as they can be more readily filed as a part of the permanent record of the application.

In *Ex parte* Hunter, *supra*, the question considered was

as to the *completion* of the invention before the date of the reference. The showing was clearly sufficient to show a conception of the invention in 1883, the references cited being a publication bearing date 1887, and two patents the applications for which were filed July 30, 1887, and March 5, 1888, respectively. The affidavit stated that the invention as shown was embodied in a car constructed in the year 1887, and that other cars embodying it were begun in the early spring of 1888, and had been used since September 4, 1888. On this showing the Commissioner held as follows:

> "It therefore appears, if it be conceded that the drawing discloses the invention, and of this there seems to be no doubt, that in 1883 petitioner had a conception of the invention, but that there was no complete reduction to practice of the same until after the dates of the references. The invention in controversy, therefore, can not be said to have been completed before such reference dates. If the petitioner is entitled to his patent in the face of the disclosure of the references, it must appear, as was stated by Mr. Commissioner Paine, that he has connected his prior conception by due diligence with his subsequent reduction to practice. Such diligence has not been shown. It is true that petitioner avers 'he has used every diligence possible in putting the invention into use,' but a mere statement of this character unaccompanied by any facts which tend to show such diligence is not a sufficient compliance with the rule as interpreted by the office."

It is an exceedingly liberal rule that permits the withdrawal from the public of an unclaimed invention in a prior patent; and it is believed for this reason that the requirements of Rule 75 should be strictly enforced. The *ex parte* showing required by this rule should be such as to establish the same state of facts as would be required in an interference between the application and patent. To this effect is *Ex parte* Grosselin, 97 O. G., 2977, in which Commissioner Allen held as follows:

> "The statutes make no provision directly by which an applicant may establish his right to a

> patent over a reference showing and describing but not claiming, the invention by proving that he is in fact the first and original inventor. There can be no contest where the reference is not a United States application or patent claiming the invention. By analogy to the statute relating to interferences, however, the applicant should be permitted to show in some way that he is the prior inventor and entitled to a patent in spite of the reference, and since there can be no contest the Office, by Rule 75, permits him to make an *ex parte* showing of his rights. In that *ex parte* showing, however, it requires the same kind of facts to be set forth which, if true, would establish *prima facie* his right to a patent even if the reference claimed the invention. The whole proceeding is by analogy to the interference practice, and therefore it follows that practice as closely as possible. This is necessary for the protection of the public."

Accordingly, therefore, it is not sufficient, in order to overcome a prior patent as a reference, to show that before the date of the application on which the patent was granted, the invention had been reduced to practice by the applicant, if the knowledge of his invention was deliberately concealed from the public until after the grant of said prior patent. See Mason *vs.* Hepburn, 84 O. G., 147.

If the Examiner is of the opinion that an affidavit filed under Rule 75 is insufficient, he should reject for that reason (*ex parte* Donovan, *supra*).

A deposition taken in an interference proceeding is an affidavit under the meaning of Rule 75 and should be received as such (*Ex parte* Keller, 61 O. G., 1790).

Affidavits filed by a party under Rule 75 should be sealed up or removed from the file before the papers in the case are thrown open to the inspection of opposing parties in an interference (*Ex parte* Gasser, *supra*, and Davis *vs.* Ocumpaugh *vs.* Garrett, 103 O. G., 1679).

The filing of an incomplete application does not constitute "a completion of the invention" within the meaning of Rule 75, as no patent can be granted on an applica-

tion until it is complete (*Ex parte* McElroy, 140 O. G., 1207).

RULE 94.

The affidavit required by Rule 94 is not of the same character as that required by Rule 75, since Rule 94 does not call for the showing of facts required by Rule 75. The reason for this is clear, since as a result of an oath filed under Rule 94, the application will go into an interference, in which, in an *inter partes* contest, will be proven the same facts that would be required to be set forth *ex parte* under Rule 75, if the patent did not claim the invention. See Ries *vs.* Thomson, 57 O. G., 1598, and *Ex parte* Davis, 62 O. G., 1516.

RULE 96.

Present Rule 96 reads as follows:

> "Whenever the claims of two or more applications differ in phraseology, but cover substantially the same patentable subject-matter, the examiner, when one of the applications is ready for allowance, will suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner will send copies of the letter suggesting claims to the applicant and to the assignees, as well as to the attorney of record in each case. The parties to whom the claims are suggested will be required to make such claims and put the applications in condition for allowance within a specified time in order that an interference may be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed unless the time for making the claim and putting the application in condition for allowance be extended upon a proper showing.

> If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of such party will be held for revision and restriction, subject to interference with other applications."

This rule was adopted for the purpose of carrying into effect the practice set forth by Hammond *vs.* Hart, 83 O. G., 743. Preceding this rule, but subsequent to Hammond *vs.* Hart, Rule 96 read as follows:

> "Whenever two or more applications disclose the same invention, and one of said applications is ready for allowance and contains a claim to said invention, the primary examiner will notify the other applicant of such fact, furnish him with a copy of the patentable claim, and require him to make such claim and put his case in condition for allowance within a specified time, so that an interference can be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed unless the time for making the claim and putting the application in condition for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of such party will be held for revision and restriction, subject to interference with other applications."

It will be observed that present Rule 96 differs from this earlier rule principally in the fact that under the earlier rule, in order to warrant the suggestion of claims, it was only necessary that the several applications should *disclose* the common invention; while under the present rule the claims of the applications must cover substan-

tially the same patentable subject-matter in order to authorize the examiner to suggest claims to this subject-matter. The former rule was obviously not in accordance with Hammond *vs.* Hart, and was superseded by the new rule for that reason.

It will be interesting, and it is believed instructive, as to the meaning of Rule 96, if the development of the practice of declaring interferences from Ex parte Upton, 27 O. G., 99, up to the adoption of present Rule 96 be considered. In Ex parte Upton, which was rendered by Commissioner Butterworth, the following was stated:

> "The examiner says:
>
> " 'This appeal is taken from the action of the primary examiner refusing a patent to the applicant, in view of Patent No. 282,449 to T. H. Dodge July 31, 1883, and involves a question of practice as to the right of the examiner to cite as a reference a patent granted on an application pending at the same time with the application under consideration.
>
> " 'The application at issue was filed June 25, 1883. That of the patentee, Dodge, was filed December 15, 1879, and a patent accordingly issued as above July 31, 1883. No question is here raised as to the pertinency of the reference from lack of identity of subject-matter. In fact, it is acknowledged to be generically the same in both. Dodge, the patentee, made one very limited claim to the construction shown and described. The applicant makes broad claims to the genus, and denies the right of the examiner to cite said patent, holding that under the rules either an interference should be declared or both patents allowed to issue, and cites Rule 74 as sustaining his views. No interference exists nor has at any time existed.'
>
> "The examiner is in error as to there being no interference. An interference does and did exist. The spirit of the interference rule is not that claims must conflict in terms in order to constitute an interference, but that the subject-matter claimed must conflict. It is not necessary that the

> claims should be so alike that the claim in either case will apply just to the matter or device of the other. If the claim of one party will include that of the other, there is an interference in fact. The Dodge case having got to issue, the examiner was right in citing the patent to the applicant. It should be settled in the Patent Office who is entitled to the broad claim, and this should appear as the result of an interference proceeding.
>
> "Neither the spirit of the law nor public policy sanctions the granting of patents with specific claims while applications with generic claims which include the specific claim allowed, are still pending, the objection being that whether the application with the generic claim pending belongs to the same party who has a specific claim under the genus, or is an application of a different party, a patent covering by a generic claim, if a subsequent patent, improperly extends the monopoly."

The practice under the Upton decision, therefore, was to declare an interference between two or more applications whenever any one or more of the applications contained a claim or claims which were broad enough to dominate or include the claims made in the other applications. These broad claims were made the issue of the interference, and the interference was declared without the suggestion of claims, and in many cases, probably in most cases, the limited claims were such as could not have been made by the party making the broad claims.

This practice was followed until Reed *vs.* Landman, 55 O. G., 1275, rendered by Commissioner Mitchell in 1891. In this case an interference had been declared between Reed's application containing broad or dominating claims and Landman's patent, none of whose claims could have been made by Reed. After a rather extensive review of the decisions of the courts and a very full consideration of interferences between applications and between applications and patents in the Patent Office, the Commissioner arrived at the following conclusions:

1. That interferences in the Patent Office, like

interferences in the courts, exist only when the claimed inventions conflict.

2. That generic and specific claims based upon the same structure of invention conflict because the invention is one and the same, whether generically or specifically stated.

3. That an interference should not be declared between an unexpired patent which shows and claims one species of an invention and a subsequent application disclosing another and different species, even though the latter contains a claim of sufficient scope to include the species claimed in the unexpired patent.

4. That where a patentee claiming specifically would be entitled to all of his claims, even if he were an applicant, in spite of a judgment of priority in favor of his opponent, the fact that his opponent's claim would dominate his own is no sufficient reason for declaring or continuing an interference. Rule 75 provides for precisely such a case, and unmistakably states that on filing the proper antedating oath, the unexpired patent shall cease to be a bar.

It was accordingly decided, therefore, by this decision, that in the case of an application and a patent, in which the only claims in the patent were specific to a structure different from that of the application, no interference should be declared between the application and the patent, notwithstanding that the applicant made claims which would dominate or include the claims of the patent. It was, perhaps, not quite clear from this decision whether or not an interference should be declared between two applications, one of which made broad claims and the other of which had only claims limited to a structure different from that of the application having the broad claims. It was made clear, however, in the later decision of Kinyon *vs.* Carter, 66 O. G., 513, that in such cases an interference ought to be declared. Assistant Commissioner Fisher, in rendering this decision, stated:

"Applicant Kinyon has a broad claim, which covers not only the particular form shown in his

application, but also the form shown in Carter's application. Carter's application has one claim, which is limited to the specific form shown. Kinyon, the applicant having the broad claim, is the one who seeks to have the interference dissolved.

"The question to be decided, therefore, is whether or not it is proper to declare an interference between two applications which show and claim different species and only one of which has a claim broad enough to cover both species. If each application contained this broad claim, it is unquestionable that an interference ought to be declared. (Searle *vs.* Frumveller *vs.* Sessions, C. D. 1892, 27; 58 O. G., 804; Dodd *vs.* Reading, C. D. 1892, 49; 58 O. G., 1413.)

"If one of the cases is a patent and the other an application and the patent contains narrow claims to one species and the application broad claims dominating those of the patent and specific claims directed to a different species, it is also unquestionable that an interference ought not to be declared. (Reed *vs.* Landman, C. D. 1891, 73; 55 O. G., 1275; Zeitinger *vs.* Reynolds *vs.* McIntire, C. D. 1891, 212; 57 O. G., 1279.)

"It becomes necessary, therefore, to consider whether the principle governing the present interference is the same as that governing the interference between a patent and an application.

"It is obvious that the applicant Carter might have had a claim in his application as broad as the broad claim in the Kinyon application. In such case an interference would be proper. It is also obvious that the applicant having the narrow claim may not wish to contest the interference. In such case he might file a disclaimer, under Rule 107, and the interference would be dissolved as a matter of course. If, however, an interference had never been declared, both cases would have been passed to issue and the applicant having the single narrow claim would find his patent dominated by the patent having the broad claim without having had a chance to have decided by an

interference which party was entitled to the broad claim as being the original inventor. His only remedy, as far as this Office is concerned, would be to file a reissue application and demand that it be put in interference with the patent containing the broad claim. If this should be done and he should succeed in this interference, the reissued patent would contain the broad claim and the claim to the species shown in his application. There would then be extant two patents having an interfering claim. This would necessitate a suit in equity if either patentee wished to have the broad claim of the other patentee declared void. Necessarily this would result in an increase of litigation, and if interferences in this office have any justification it is that they should, in some measure, prevent litigation by having only one of the interfering applications mature into a patent.

"I therefore think the action of the examiner in declaring an interference was proper. If the applicant having the narrow claim does not choose to contest the interference, he can easily avoid such a proceeding by filing a disclaimer under Rule 107. For the applicant having the broad claim, as in the present case, to bring a motion for dissolution seems indefensible. He practically asks that the broad claim be allowed to him and refused to another applicant who has a right to make it."

The practice under Reed *vs.* Landman and Kinyon *vs.* Carter continued until Hammond *vs.* Hart, before referred to. In this case, in which an interference had been declared between the pending applications, Commissioner Duell, after a review of the court decisions, stated at length his reasons for disagreeing with Ex parte Upton, Reed *vs.* Landman and Kinyon *vs.* Carter. These reasons may be more briefly stated as follows:

That it is not the province of the Patent Office to settle who is entitled to any claim, broad or narrow, unless an applicant first makes the claim. In the case of *Ex parte* Upton, since the patent contained no claim for the broad

invention, if the applicant complied with the requirements of Rule 75, he would have done all that should have been required of him to have had his claim allowed without an interference. That the spirit of the law can only be determined by its language and by the decisions of the courts construing this language. That it is unsafe to conclude that what the law requires is contrary to public policy. Further, that the objection of an improper extension of the monopoly is not well founded. That under a long line of reported cases a patent with a specific claim and one with a generic claim would undoubtedly be held not to be interfering patents. That a monopoly is extended only when two patents claim the same thing in the same breadth. That so far as the Upton case holds that an interference should be declared between two applications or between an application and a prior patent whose claims are not substantially identical in tenor and scope it is not well founded in law.

As to Reed *vs.* Landman, Commissioner Duell did not agree that "generic and specific claims, based on the same structure of invention conflict, because the invention is one and the same, whether generically or specifically stated." The Commissioner, however, stated that—

> "It is not essential to the decision of this case to assert that this contention is clearly erroneous, and the necessity for its application to any given case hereafter can easily be avoided. Where two applications are concurrently pending having claims of different scope drawn on the same structure, I see no good reason why the examiner should not give the applicant making the specific or narrow claim an opportunity, by suggestion, if necessary, to make the broader claim. If the suggestion is followed, then the parties would be making a claim identical in tenor and scope, and an interference will properly and naturally follow."

Commissioner Duell also disagreed with Kinyon *vs.* Carter in holding that an interference exists when different specific forms are shown by two applicants, both

capable of being covered by a broad claim, although but one of the applicants makes the broad claim, while the other makes a claim limited to his species, holding that the same rule is to be applied in an interference between two applications, and one between an application and a patent. In both cases an interference does not and can not legally exist unless the claims are coextensive.

This part of the decision concludes as follows:

> "Reviewing the uniform decisions of the courts and the conflicting decisions of the Patent Office, giving due weight to the reasons adduced for arriving at the various conclusions, and noting the authorities sustaining the various conclusions, whenever authorities have been cited, I am of the opinion that an interference can only be instituted for the purpose of determining the question of priority of invention between two or more parties *claiming* substantially the same patentable invention; that of necessity there must be allowed claims to all parties before an interference can be declared, and that only a patent and an application must claim in whole or in part the same invention, but also two applications must claim in whole or in part the same invention before an interference can be declared."

Present Rule 96 was adopted for the purpose of carrying into effect the practice approved by Hammond *vs.* Hart, and under this rule and decision it is necessary, in order that an interference may properly be declared, first, that the disclosure should be of the same structure, and, second, that the claims shall be substantially identical. This last condition is secured under the rule by suggestion of the broad claim covering the subject-matter common to the applications. There is no ground, however, for the suggestion of claims in the case where an application is limited to a specific structure different from that of the application in which the broad claims are made. This is clear not only from the definite language of the rule, in which it is said that in order to authorize such suggestion the claims of the application

must "cover substantially the same subject-matter," and from Hammond *vs.* Hart, on which said rule is based, but it is also definitely required by Myers *vs.* Brown, 112 O. G., 2093, in which Commissioner Allen said:

> "Prior to the promulgation of amended Rule 96, it had been the practice to suggest claims to an applicant who had merely disclosed the invention, either in his specification alone or in his drawing alone, or in both the specification and drawing, but had failed to file any claim at all based upon such disclosure. Experience has shown the desirability of discontinuing this practice, and Rule 96 was promulgated with that end in view."

To summarize:

An interference was declared between applications or between a patent and an application under the practice as established by the decisions hereinbefore referred to, as follows:

Under *Ex parte* Upton:

1. Between claims of the same scope.
2. Between a broad or dominating claim and a specific claim, whether or not the claims were based on the same structure.

Under Reed *vs.* Landman and Kinyon *vs.* Carter:

1. Between claims of the same scope.
2. Between a broad or dominating claim of one application and a specific claim of another application, whether or not the claims were based on the same structure.
3. Between a broad or dominating claim of an application and a specific claim of a patent only when based on the same structure.

Under Hammond *vs.* Hart and present Rule 96:

Between claims of the same scope only.

It is no simple matter to formulate a rule for the declaration of interferences which will observe both the

rule that pending applications are to be preserved in secrecy, and the one that interfering applications should claim the same invention. Ex parte Upton, Reed *vs.* Landman and Kinyon *vs.* Carter violated the second of these rules. Present Rule 96 violates neither. The trouble with Rule 96, however, is that, under penalty of an implied disclaimer of the invention if he fails to do so, an applicant is compelled to adopt a suggested claim based on a structure which he is not permitted to see, and which claim, therefore, he often can not understand.

In the event that an applicant does not understand a suggested claim, or its patentability over the prior art, he should adopt it, although under protest, the question of the patentability of the claim being reserved for determination subsequently on a motion for dissolution (*Ex parte* Zamboni, 20 Gour., 22-14).

There are several classes of cases in which claims may be suggested under Rule 96.

1. In pending applications where claims are made in both applications based on identically the same structure, *i. e.*, where the claims in each application will read exactly on the disclosure of the other.

2. In pending applications where one application contains a claim broad enough to read on the disclosure of the other while the claims in the second application contain immaterial limitations not found in the first.

3. In pending applications where the claims in each application will read on the other except for immaterial limitations contained in the claims of each application.

4. In a pending application when a claim is made in a patent broad enough to read on the disclosure of the application and the claims in the application also read on the disclosure of the patent.

5. In a pending application when a claim is made in a patent broad enough to read on the disclosure of the application and the claims of the application will read on the patent except for immaterial limitations.

6. In a pending application when the claims therein will read on a patent and the claims of the patent will read on the disclosure of the application except for immaterial limitations.

7. In a pending application when the claims of a patent and those of the application are such that the claims of each case will read on the other except for immaterial limitations.

The practice as to the first class of cases is clear and is directly covered by the rule. The broad claims of each application should be suggested for adoption in the other application.

In the second class of cases the rule also applies, since because the limitations are immaterial the claims of the two applications cover *substantially* the same subject-matter. The broad claims should be suggested in the application having the limited claims.

In the third class of cases neither party makes a claim which can form the issue of an interference, but it is apparent that the claims in both cases should not be allowed, since neither device is patentable over the other. The examiner, therefore, should suggest a claim to each party which will cover the invention common to both, omitting immaterial limitations. Such a practice is authorized by *Ex parte* Thompson, 98 O. G., 227, in which the Commissioner said:

> "Rule 96 permits the examiner to suggest to one party an allowable claim made by another, so as to bring about a proper interference, when they are both claiming the same thing in different ways, but it does not in terms permit the suggestions to both parties of a claim not made by either. The suggestion of such a claim, however, in a case like the present to cover the real invention common to the two cases clearly comes within the spirit of the rule. The purpose of the rule and the recent practice of the office are not to avoid interferences between applications because of some differences in the form of the claims, but merely by suggestions to bring the parties together upon an issue which shall be as nearly as possible the

> same as the claims of the parties, so as to reduce to a minimum the chances for motions and controversies during the progress of the interference based upon differences in the claims. There is nothing in the rule which prohibits the suggestion of a claim to constitute the issue in a case of this kind, and the suggestion would be in accordance with the general purpose of the Rule."

In the fourth and fifth classes, the broad claim of the patent should be suggested to the applicant and a time limit set within which to make such claim the same as in the case of pending applications. This practice is authorized by *Ex parte* Card & Card, 112 O. G., 499, in which the Commissioner said:

> "It must be held as a matter of procedure that the examiner was right in suggesting the claims of the patentee to these applicants and in his statement that if they failed to make them certain of the claims which they now make will be rejected. An applicant can not be permitted to avoid an interference with a patentee by carefully avoiding the words of his claims when the real invention is the same. When he claims substantially the same thing he can secure his patent only by proving priority of the invention in the regular way.
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> . . . . . .
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> "The petitioners make the additional point that even if it was proper to suggest the patentee's claims to them, it was not proper to fix a time limit within which they should make them. They say it might be proper to fix a time limit if the other party was an applicant; but it is not proper where the other party is a patentee. It seems perfectly clear that if these applicants are to have the option of either making the claims of the patent and contesting an interference or of having their present claims rejected *ex parte* it is necessary to fix a time limit within which they shall choose. There seems to be no reason why they should not make the claims of the patentee

> within a reasonable time if they intend to make them, and it is no injustice to hold them estopped after a time specified. In regard to interferences it is a matter of practical necessity and has always been considered proper to fix time limits, because of the interests of the opposing party. No good reason is seen for departing from that practice."

The sixth and seventh classes of cases are the only ones in which an interference may be declared including a claim which is not in the exact terms of the issue. This for the reason that the only claim or claims to the common subject-matter in the patent contain immaterial limitations not found in the application and because the patent is not subject to amendment like an application. There can be no question, however, that an interference should be declared, since the invention is substantially the same notwithstanding the immaterial limitations. As was said in *Ex parte* Thompson, *supra:*

> "It is not believed that the decisions cited and others of the same character were intended to mean that there is in law no interference in fact in a case of this kind, where the real invention claimed is the same in both cases, merely because the claims differ in the statement of the specific form of one of the elements of the combination. If those specific elements are the mechanical equivalents of each other, there is an interference under the well-settled principles of law. Winans *vs.* Denmead, 15 How., 330; Rodebaugh *vs.* Jackson, C. D., 1889, 435; Reece Button-Hole Co. *vs.* Globe Co., C. D., 1894, 360. Each party's device would infringe the other's claim under the doctrine of mechanical equivalents, and under such circumstances it can scarcely be said that there is no conflict."

The patentee's claim with the immaterial limitations omitted would form the issue of the interference and should be suggested to the applicant.

In some instances there should be a liberal application

of the rule in regard to the suggestion of claims, as, for instance, where an applicant is prosecuting his own application, or where by amendment in view of a rejection an applicant cancels a broad claim substantially the same as one subsequently allowed in another application. When an applicant, however, is represented by a competent attorney, and it is clear that at no time during the pendency of the application was there any intention to cover anything but the applicant's specific structure, under present Rule 96, and the decisions bearing thereon, especially Hamond *vs.* Hart, on which said rule was based, there is no warrant for the suggestion of a broad claim made in another application.

RULE 124.

Rule 124 in the Revised Edition of the Rules of Practice of July 1, 1891, reads as follows:

> "Appeal may be taken directly to the Commissioner from decisions of the primary examiner on all motions except the following: (1) on motions to dissolve which deny the patentability of applicant's claim; (2) on motion to dissolve which deny the right of an applicant to make the claim; (3) on motions involving the merits of the invention. Decisions on these motions, when appealable, go to the Examiners-in-Chief; and upon such appeals, the party only whose claim is affected should have the right to appear and be heard.
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> "From a decision of the Primary Examiner affirming the patentability of the claim or the applicant's right to make the same, no appeal can be taken."

It will be observed that under this rule the appeal from the Examiner's decision upon a motion to dissolve was heard *ex parte*. In the later editions the rule was amended to require that the appeal be heard *inter partes*. In the case of Newcomb *vs.* Thomson, 122 O. G., 3012, and 122 O. G., 3013, an interference was declared between a patent to Newcomb and an application of Thomson. A motion was brought by Newcomb to dis-

solve the interference on several grounds, and this motion was granted by the Primary Examiner. Attempt was made by Thomson to avoid the *inter partes* hearing required on appeal from the Examiner's decision in this manner: Appeal was taken from this motion to the Examiners-in-Chief, but was subsequently withdrawn and the interference dissolved. The Thomson application was then taken up for *ex parte* consideration, and the claims which had been involved in the issue were twice rejected on the ground stated in the decision granting the motion to dissolve. Thereupon Thomson took an appeal, *ex parte*, to the Examiners-in-Chief, who reversed the decision of the Primary Examiner. The interference was then reinstated, and time set for taking testimony. Motion was then brought by Newcomb to vacate the official action reinstating the interference, and by the appeal from the denial of this motion the case came before the Commissioner. In order to prevent this manner of avoiding an *inter partes* appeal, and also to avoid an appeal *inter partes* on the motion to dissolve and an appeal *ex parte* on the rejection of the claims after dissolution of the interference, the Commissioner stated:

> "It was my intention in the decision, to which this is a supplement, to institute a practice by which parties must appeal *inter partes* and in a reasonable time where there has been a holding upon motion for dissolution against the merits of their cases if they would appeal at all, and it was also my intention that the Examiner should take such action subsequent to his decision upon the motion as will put the cases in condition for the statutory appeal so that appeal might be continued directly to the court of appeals without the necessity of a second course of appeals through the Patent Office."

In order to carry this practice into effect, Rule 124 was later amended to read as follows:

> "Where, on motion for dissolution, the primary examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable or that a party has no

right to make a claim or that the counts of the issue have different meanings in the cases of different parties, he shall at once reject such claims as may be affected and shall set a time for reconsideration; after reconsideration, if he adheres to his original conclusion, he will make the previous rejection final and fix a limit of appeal. The appeal must go to the Examiners-in-Chief in the first instance and will be heard *inter partes*. If the appeal is not taken within the time fixed, it will not be entertained except by permission of the Commissioner.

"No appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same or the identity of meaning of counts in the cases of different parties."

"Appeals may be taken directly to the Commissioner, except in the cases provided for in the preceding portions of this rule, from decisions on such motions as, in his judgment, should be appealable."

It is to be especially noted that the change in practice indicated in Newcomb *vs.* Thomson and in Rule 124 was necessitated, as stated in said decision, by the refusal of the court to receive appeals on motions. Following this decision a petition was filed for a writ of mandamus against the Commissioner of Patents directing him to vacate and set aside the proceedings in the Patent Office just referred to (Newcomb Motor Co. *vs.* Commissioner of Patents, 130 O. G., 302.) This petition being dismissed, appeal was taken to the Court of Appeals of the District of Columbia, (133 O. G., 1680), and after a full discussion of the case the court decided that when the appeal from the decision of the Primary Examiner was abandoned his decision became final and binding upon the parties, or in other words, that no subsequent *ex parte* action could be taken. Attention is also called to Cosper *vs.* Gold and Gold, 168 O. G., 787, in which the Court of Appeals of the District of Columbia held that where the Commissioner of Patents affirms a decision dissolving an interference on the ground that one of the

parties thereto has no right to make the claims, the Commissioner has jurisdiction to award priority to the other party, since the question of the right to make the claims is ancillary to that of priority.

These decisions avoid the necessity of rejecting the claims at the time that the adverse decision is rendered on the motion for dissolution, since if the appeal from the decision of the Primary Examiner is abandoned his decision becomes final and binding upon the parties under the decision of the Court of Appeals of the District of Columbia; and if appeal is taken up to the Commissioner and his opinion is adverse to the right of an applicant to make the claims, he can award priority to the other party, from which decision appeal can be taken to the court.

Accordingly, the first paragraph of Rule 124 was superseded by the first paragraph of present Rule 124, which reads as follows:

> "Where, on motion for dissolution, the Primary Examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable or that a party has no right to make a claim, or that the counts of the issue have different meaning in the cases of different parties, he shall fix a limit of appeal not less than twenty days from the date of his decision. Appeal lies to the Examiners-in-Chief in the first instance and will be heard *inter partes*. If the appeal is not taken within the time fixed, it will not be entertained except by permission of the Commissioner."

January 7, 1915.